

Serial No.: 09/719,870

Responsive to Office Action dated May 18, 2006

Amendment Filed: September 18, 2006

REMARKS/ARGUMENTS

Reconsideration of this application in view of the foregoing amendments and the following remarks is respectfully requested.

With this amendment, claims 2, 36 and 43-46 remain in the application.

Claim 2 has been amended to more clearly define the invention.

Claim Rejections 35 USC §102

Wilds et al.

Claims 2, 36 and 43-46 stand rejected as being anticipated under 35 U.S.C. 102(a) by Wilds et al. Applicant respectfully submits that Wilds et al. is not properly citable under 35 U.S.C. 102(a). Wilds et al. was published in March, 1999. The present application stems from WO 99/67378, the cover page of which is enclosed for the Examiner's reference. WO 99/67378 bears an international filing date of June 17, 1999 and a priority date of June 19, 1998. The priority document was provided to the International Bureau during the international phase and supports the currently pending claims. The Examiner's attention is drawn specifically to the oligonucleotides prepared in tables 1 and 2 pursuant to Examples 1 and 2. Specifically, oligonucleotide VII in table 2 is a mixed-based, uniformly modified oligonucleotide. Additional disclosure regarding this oligonucleotide can be found in Example 4 on page 31. The Examiner is kindly asked to also note generally the description at page 15, paragraph 2; page 20, paragraph 2 and page 21-23.

As such, this priority date establishes the prima facie *latest* date of invention as being June 19, 1998. Applicant respectfully submits, therefore, that Wilds et al. is not properly citable under 35 U.S.C. 102(a).

Kois et al.

Claims 2, 36 and 44-45 stand rejected under as being anticipated by Kois et al. under 35 U.S.C. 102(b). Applicant has amended claim 2 to recite that the oligonucleotide is a mixed base oligonucleotide. Support for this amendment is clearly found in the application as filed and more particularly in Examples 2, 3, 4, 6 and 9.

Kois et al. neither teaches nor suggests *mixed based* oligonucleotides consisting of all 2'-deoxy-2'-fluoro-β-D-arabinonucleotides. As noted by the Examiner, the poly FMAU sequence of Kois et al.

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could in theory bind to the poly(A) tail of *any mRNA*. Advantageously, a mixed base oligonucleotide can provide gene specific binding as opposed to non-specific (i.e. poly-A tail binding).

Manoharan et al.

Claims 2, 36 and 43-46 stand rejected as being anticipated by Manoharan et al. under 35 U.S.C. 102(e). Applicant respectfully submits that Manoharan et al. is not properly citable under 35 U.S.C. 102(e). As noted above, the priority date of the present application establishes the *prima facie latest* date of invention as being June 19, 1998, which is prior to the filing date of Manoharan et al.

Claim Rejections 35 USC §103

Claims 2, 36 and 43-46 stand rejected as being obvious having regard to Cheng et al. in view of Wilds et al. As Applicant has established that Wilds et al. is not citable, the Examiner's rejection in this regard is considered moot.

It is submitted, therefore, that the claims are in condition for allowance. Reconsideration of the Examiner's rejections is respectfully requested.

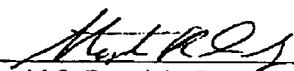
In the event that there are any questions concerning this amendment or the application in general, the Examiner is respectfully urged to telephone the undersigned so that prosecution of this application may be expedited.

The Examiner is authorized to charge required fees, fee deficiencies or credit any overpayments associated with this submission to the NIXON PEABODY LLP Deposit Account No. 19-2380.

Date: September 18, 2006

Respectfully submitted,

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